

DEC 14 2005

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

L0015/7000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

09/580,591

Filed

May 26, 2000

First Named Inventor

Robert A. Levy

Art Unit

2155

Examiner

Won, Michael Young

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record.Registration number 42,890

Signature

Joyce C. Hersh

Typed or printed name

617-261-3100

Telephone number

 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

December 12, 2005

Date

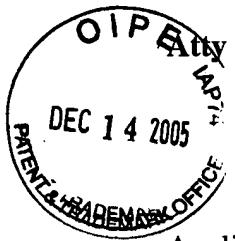
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Atty Docket No.: L0015/7000

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Robert A. Levy Examiner: Won, Michael Young
Serial No.: 09/580,591 Group Art Unit: 2155
Filed: May 26, 2000 Conf. No.: 9499
Title: SYSTEM AND METHOD FOR ANALYZING WORK ACTIVITY AND
VALUING HUMAN CAPITAL

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence (and any paper or fee referred to as being enclosed) is being deposited with the United States Post Office as First Class Mail on the date indicated in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

12-12-05

Date

Debra M. Dougherty

Signature

DEBRA M. DOUGHERTY

Typed or Printed Name of Person Signing Certificate

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**ARGUMENTS AND REMARKS FOR
PRE-APPEAL BRIEF CONFERENCE**

Sir:

In response to the Office Action mailed from the U.S. Patent and Trademark Office on August 10, 2005 in the above-identified application, Applicant requests a Pre-Appeal Brief Conference in accordance with the guidelines in the "New Pre-Appeal Brief Conference Pilot Program" announcement, which appeared in the July 12, 2005 issue of the *Official Gazette*. In accordance with those guidelines, Arguments for the conference are presented herein. Filed concurrently herewith are a Pre-Appeal Brief Request for Review (form PTO/SB/33), a Notice of Appeal, and the fee under 37 C.F.R. § 41.20(b)(1).

The issues addressed herein are ripe for appeal in accordance with 37 C.F.R. § 41.31(a)(1), the claims having been twice rejected.

ARGUMENTS

Applicant requests withdrawal of the rejection of the claims as anticipated by Beck *et al.* (U.S. Pat. No. 6,587,832) and obvious in view of Beck *et al.* and Skinner *et al.* (U.S. Pat. No. 5,963,914). Neither reference discloses the elements of the claims, nor renders the subject matter of the claims obvious.

Applicant's Invention

Applicant's invention is a system, method and apparatus for obtaining information about the work activities of an employee, in which the employee creates a profile of each of his work activities, and a value for that profile is then created.

The work profile, as entered by the employee, includes the employee's individual work activities and the percentage of his time that he spends on each of the activities. When the employee has completed his profile, a market value can be assigned to the individual employee's profile by "pricing" each of the components of the employee's job. This can be accomplished by clustering related work activities into work activity groups, each of which is treated as a separate "job part" and is valued and priced separately (page 14, line 22 - page 15, line 2). The job part pricing and the percentage of time the employee spends on each work activity group are aggregated across all of the work activity groups, to determine the overall market value of the *employee's personal work profile* (page 15, lines 14-24).

Fig. 6 shows a profile for a hypothetical employee whose job title is "editor." It reveals that employee Smith spends 5% of his time managing vendors and consultants, 15% of his time preparing corporate communications, and 80% of his time preparing in-company communications. Smith will therefore be paid as though he were 5% as a manager, 15% as a creator of the company's external communications, and 85% as a creator of the company's in-house communications (*e.g.*, company newsletters).

The Cited Art:

Beck *et al.* (U.S. Pat. No. 6,587,832; "Beck")

Beck discloses a system and a method for obtaining and using observed market rates to estimate suitable market-based compensation for a job. Observed market rates for selected jobs

are collected, and each value is assigned (1) a job family and (2) a combination of job category and responsibility level. For a given job, median market rate and average market rate are obtained for the job family, and combined through the method to produce a “job family factor” and a “responsibility level factor,” which are multiplied together to produce an accurate market compensation rate for the job.

Beck does not disclose obtaining information on the tasks actually done by an individual employee.

Skinner et al. (U.S. Pat. No. 5,963,914; “Skinner”)

Skinner teaches a system that tracks time spent by a person on a remote computer. As stated in the first sentence of the “Summary of the Invention” in Skinner, “[i]t is an object of a *time tracking system* provided according to the invention to produce automatic documentation and unalterable proof of work done on a computer” (col. 2, lines 43-45; emphasis added). Skinner refers to the disclosed system throughout as a “time tracking system” (e.g., col. 2, lines 43, 55, 61, 63; col. 3, lines 7, 14) to be used for “tracking of worked time” (e.g., col. 2, lines 65-66).

The “activities” being logged by the Skinner system are clearly network activity, electronic file activity, keyboard activity, mouse activity, and other such computer activities that can be used to prove that an employee is actually working during his time at home. These “activities” are actual times spent on various types of computer activities and are logged by the system. They are not estimates entered by the employee of the amount of time spent on various types of tasks. The purpose of the Skinner system is to provide verification of the hours employees spend actually working, especially employees who are telecommuting.

Rejection

Reconsideration is requested of the rejection of claims 1-17, 11-18, 20-26 and 28-35 as anticipated by Beck. This reference fails to disclose or suggest a system, method or apparatus for creating a value for an individual employee’s job, where the employee creates a personal profile of his job by entering the tasks that he performs and the percentage of his time spent performing them, and where the system then clusters related tasks into groups, values each group



separately, and then aggregates the parts into a whole, creating a job value individualized to that particular employee.

Beck does not require that an employee characterize their job in any way, and does not appear to break apart a job performed by a single individual in order to value the component parts.

“To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996). The requirements for anticipation are set forth in the Manual of Patent Examining Procedure § 2131.

None of the references cited, either in the current or any previous office action, discloses or suggests taking apart the job of a given employee, placing a market value on each of the parts, and then recombining them to provide a market value for the job as performed by *that given employee*. Rather, the references either disclose time-tracking systems (*e.g.*, Skinner *et al.*), or provide methods of calculating market rates for predefined jobs (*e.g.*, “Accountant,” see Fig. 2 of Beck).

Reconsideration is also requested of the rejection of claims 8-10, 19 and 27 as defining subject matter that would have been obvious of one of ordinary skill in the art over Beck and Skinner. All of the claims include the requirements that an employee create a work profile of the tasks they perform, which are then valued separately and recombined to produce a value for the job as performed by the individual employee. Where neither reference discloses such a method, their combination cannot render the method obvious, and the rejection cannot be sustained.

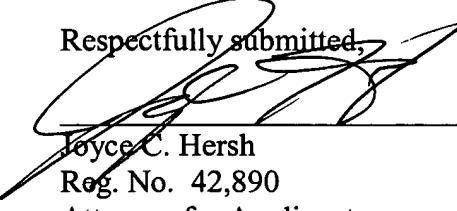
Applicant requests that the rejections be reconsidered and withdrawn.

Attorney Docket No.: L0015/7000
Inventor: Robert A. Levy
Arguments for Pre-Appeal Brief Conference

U.S. App. No. 09/580,591
Filed: May 26, 2000
Page 5

Applicants submit that all of the claims are now in condition for allowance, which action is requested. Please apply any charges or credits to Deposit Account No. 50-1721.

Respectfully submitted,


Joyce C. Hersh
Reg. No. 42,890
Attorney for Applicant
KIRKPATRICK & LOCKHART
NICHOLSON GRAHAM LLP
75 State Street
Boston, MA 02109-1808
Tel: 617-261-3100
Fax: 617-261-3175

Date: December 12, 2005